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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,929	03/09/2001	Charles Patrick Thacker	03797.00092	3449

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EXAMINER

LIU, MING HUN

ART UNIT	PAPER NUMBER
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2697

DATE MAILED: 12/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/801,929

Applicant(s)

THACKER ET AL.

Examiner

Ming-Hun Liu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
2. The attempt to incorporate essential subject matter into this application by reference to sources other than allowed or issued US patents is improper. Therefore, it is assumed that these incorporations do not include essential subject matters. If they do, these incorporations will need to be corrected.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19-20 recites the limitation "the tablet PC" in the first line of both claims. There is insufficient antecedent basis for this limitation in the claim. The problem might be due to a typographical error in claim 19. Instead of depending on claim 9, claim 19 should be dependent on claim 18. Claims 19 and 20 will be reviewed in this detailed action assuming that claim 19 depends on claim 18.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-24 rejected under 35 U.S.C. 102(e) as being unpatentable over USPN 6,262,719 to Bi et al.

In reference to claims 17-19 and 24, Bi describes a tablet PC (a pen-based portable personal computer system, column 1, lines 49-50) comprising: a digitizing writing surface (column 35, lines 26-40) generating a predetermined output; and a display showing a user interface having a plurality of soft buttons (column 3, lines 62-64) in response to the predetermined output, the plurality of soft buttons providing selectable functionality of a two-button mouse-type computer input device (column 2, lines 13-22). The plurality of soft buttons includes a right-button function (Fig. 37 item 1232), a shift function (Fig. 37 item 1480 and Figs 66a-d), a control function (Fig. 37 item 1480 and Figs 66a-d) and an alternate function (Fig. 37 items 1472 and 1474). The digitized writing surface receives a user selection of at least one of the plurality of soft buttons (column 40, lines 41-43). The predetermined output generated by the digitizing writing surface is a predetermined in-air gesture made with a digitizing pen (pen-up and pen-down events described through out i.e. column 40, line 43).

Claims 1-3 and 8 are rejected on the same grounds as the rejection outlined in claims 17-19 and 24 since the tablet PC claimed encompasses the need for a method for emulating a two-button mouse-type computer input device.

Claims 9-11 and 16 are also rejected on the same grounds as the rejection outlined in claims 17-19 and 24 since the scope of a tablet PC includes a computer-readable medium.

***Claim Rejections - 35 USC § 103***

6. Claims 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bi. The arguments provided in the rejection of claims 17-19 above are incorporated herein.

In reference to claims 20, 21 and 23 Bi describes a user interface (on-screen keyboard Fig. 65a/b) that is hidden from the view on the display when the user selected soft button is received and wherein the plurality of soft buttons includes a bull's eye-function (column 54, line 11-12 and figs 66a-d). In column 55, lines 18-23, Bi explains that this user interface is hidden from view on the display when a predetermined amount of time elapses without receiving a user selection of at least one of the plurality of soft buttons. However, Bi fails to explicitly include soft buttons that provide selectable functionality of a two-button mouse-type computer input device user interface on the user interface. As mentioned above, Bi does describe hot buttons that emulate the functionality of a two-button mouse. It would have been obvious to one skilled in the art to modify Bi's hot button toolbar to embody the same attributes of Bi's OSK user interface. This change would have come naturally if one believed that an ever-present hot button took up valuable display area and would like to have the tool bar appear only when called upon much like the OSK.

In reference to claim 22, Bi describes a tablet PC with the attributes discussed in the rejection for claims 20-21. Bi however, fails to describe the feature in the OBK

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where the tablet PC sends a right-button event to the application displayed below the user interface (the OBK) on the display in response to the user selection for the bull's-eye function. There is no disclosed criticality behind requiring the tablet PC to specifically send a right-button event to the application below. The importance lies in the need to reinstate the tablet PC to the job that it was performing before the user interface was invoked. Bi describes an algorithm that does just so in column 54, lines 38-41 continued in column 55, lines 32-49.

Claims 4-7 and 12-15 are rejected on the same grounds as the rejections outlined for claims 20-23.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ming-Hun Liu whose telephone number is 703-305-8488. The examiner can normally be reached on Mon-Fri.

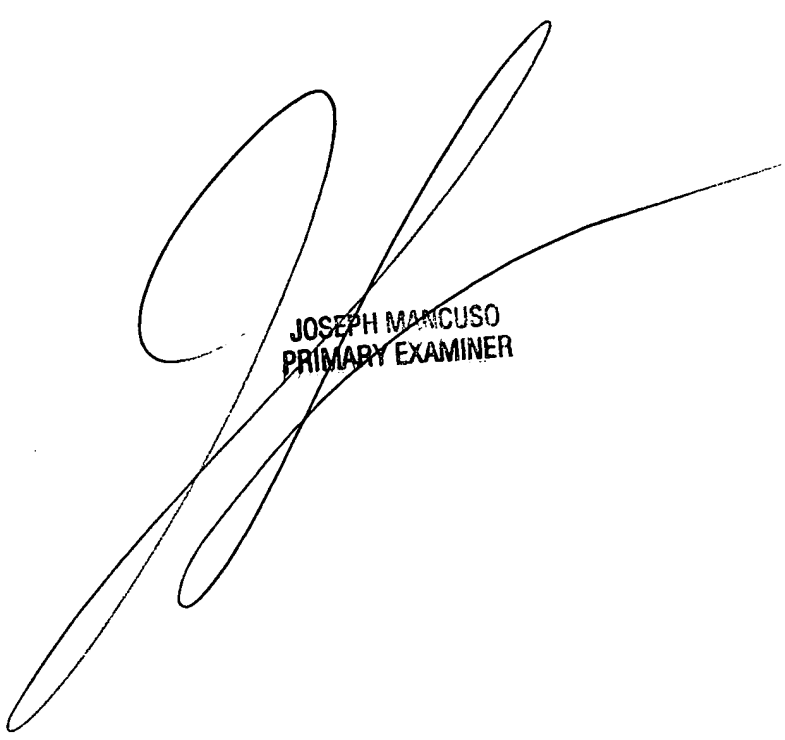
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Mancuso can be reached on 703-305-3885. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.

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Ming-Hun Liu

December 9, 2002



JOSEPH MANCUSO  
PRIMARY EXAMINER